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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/825,359

04/16/2004

Peter Gibson

COCH-0009-1

8104

22506 7590 01/31/2007
JAGTIANI + GUTTAG
10363-A DEMOCRACY LANE
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EXAMINER

HOLMES, REX R

ART UNIT

PAPER NUMBER

3762

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/31/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/825,359

Applicant(s)

GIBSON, PETER

Examiner

Rex Holmes

Art Unit

3762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-88 is/are pending in the application.
- 4a) Of the above claim(s) 3, 13, 15-19, 25, 26, 40-43, 49, 50 and 57-88 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-12, 14, 20-24, 27-39 and 51-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/16/04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>8/16/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group 1 and Embodiments 1, 4 and 9, in the reply filed on 10/27/06 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claim 3, 13, 15-19, 25-26, 40-43, 49-50 and 57-88, withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Group/Species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 10/27/06.
3. The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 1-56 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. Claim 1 is vague and unclear as it states "a housing to be secured to a patients bone", a system claim cannot claim a connection to a body. It is suggested to use "adapted to be" or "for securing" instead of "to be".
7. Claim 7 recites the limitation "the tissue-stimulating prosthesis" in lines 1 and 2 of the claim. There is insufficient antecedent basis for this limitation in the claim.

8. Claim 8 recites the limitation "the cochlear implant" in line 2 of the claim. There is insufficient antecedent basis for this limitation in the claim.
9. Claims 11 and 12 are vague, as a device cannot claim a bone or periosteal pocket, it is suggested to put the claims in functional language relative to a claimed element.
10. Claim 32 is vague and unclear as it states "a housing to be secured to a patients bone", a system claim cannot claim a connection to a body. It is suggested to use "adapted to be" or "for securing" instead of "to be".

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1-2, 4, 7-12, 14, 20, 32-35, 38-39, 44 and 47 are rejected under 35 U.S.C. 102(e) as being anticipated by Westerkull (U.S. Pat. 7,043,040).
13. Westerkull discloses a hearing aid/cochlear apparatus that comprises a housing adapted to abut the patients bone (Figure 2, element 8), components located within the housing (8), and an osseointegrating protuberance that extends from the housing into the bone (Element 3; Abstract; Col. 2, ll. 16-22). Westerkull further discloses that the housing contains a stimulating unit and a receiver (Col. 2, ll. 50-55; Col. 3, ll. 15-24).

14. Westerkull discloses that the implantable device is configured, to be secured to the mastoid portion of the temporal bone in the tissue surrounding the skull (Fig. 1-3). Westerkull further discloses that the fixation device is a threaded screw and is capable of being removed after osseointegration (Figs. 1-3).

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 24, 27-31, 48 and 51-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Westerkull.

17. Regarding claims 27-28 and 51-53, Westerkull discloses the claimed invention including osseointegration but does not disclose the type of material that is used to encourage osseointegration. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the hearing aid as taught by Westerkull, with titanium or another biocompatible material that enhances osseointegration since it was known in the art that those materials are biocompatible, and that biocompatible material are required to make implantation successful, and in order to have osseointegration, the biocompatible material has to encourage osseointegration.

18. Regarding claims 24, 29-31, 48 and 54-56, Westerkull discloses the claimed invention including osseointegration but does not disclose whether the case

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osseointegrates or what the case is formed out of. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the hearing aid housing as taught by Westerkull, with a biocompatible material that prevents osseointegration since it was known in the art that electrical components become outdated and need to be replaced, and the prevention of osseointegration of the housing allows for easy replacement of the components.

19. Claims 5-6, 21-23, 36-37 and 45-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Westerkull as applied to claims 1, 4, 32, 35 above, and further in view of Håkansson (U.S. Pat. 6,840,919).

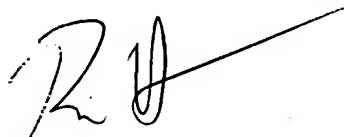
20. Regarding claims 5-6, 21-23, 36-37 and 45-46, Westerkull discloses the claimed invention as described in detail above, except for the elongated flanges that hold the disposed protuberances at opposing angles. Håkansson teaches that it is known to use flanges and anchoring devices that are disposed at an opposing angle that is approximately 85 degrees and in the same plane as set forth in Figures 1 and 2 to provide anchoring means for the implantable device. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the hearing aid as taught by Westerkull, with flanges and multiple anchors disposed in the flanges at opposing angles as taught by Håkansson, since such a modification would provide the hearing aid with strong anchoring means for providing increased hold and more surface area for osseointegration.

Conclusion

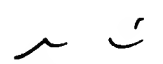
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rex Holmes whose telephone number is 571-272-8827. The examiner can normally be reached on M-F 8:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 571-272-4955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Rex Holmes
Examiner
Art Unit 3762



George Evanisko
Primary Examiner
Art Unit 3762

1/29/7